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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,618	03/27/2006	Hartmut Nitzsche	101914450	9019
26646 7590 01/07/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER NGUYEN, HANH N				
ART UNIT 2834		PAPER NUMBER		
MAIL DATE 01/07/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,618

**Applicant(s)**

NITZSCHE, HARTMUT

**Examiner**

HANH N. NGUYEN

**Art Unit**

2834

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 17-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 17, the limitation “the at least one first support surface and the at least one second support surface have a lateral clearance from each other” and “the at least one first elastic element bridges the lateral clearance in the form of a first free bridge” is not understood by an ordinary skill in the art.

Figures 1, 2 show holding tab 17 formed on the stator frame of motor 12. Holding tab 17 is covered on two sides by damping element 21 as shown in Fig. 1. The side wall 28 of damping element 21 is between holding tab 17 and pocket side wall 8'. As best understood by the Examiner and shown in Fig. 3, the first support surface 30 is the surface of the overlapping region of the holding tab 17 and elastic member and the second support surface 31 is the overlapping region of the pocket side wall 8' and the elastic member. However, as shown in Fig. 2, there is no lateral clearance between first support surface 30 and the at least one second support surface 31 and the disclosure

does not show how the lateral clearance 32 is formed in Fig. 3. Fig. 4 shows an embodiment quite different from Fig. 2 with two holding tabs 17 on one side of the elastic member and pocket side wall 8' on the other side (please see markups in previous Office Action).

### ***Response to Arguments***

2. Applicant's arguments filed on 10/20/2008 have been fully considered but they are not persuasive. Again, the applicant's position is still on the ground that the Examiner only stated that claim 17 "is not understood to an ordinary skill in the art" instead of considering several factors in an analysis for compliance with the enablement requirement are: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill in the art; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. Moreover, Figs. 3 and 4 schematically show further exemplary embodiments of the damping device that may not necessary be the same with embodiment shown in Fig. 2; Figs. 1, 7 and 9 show a lateral clearance between tabs 17 and wall 8, 8'.

The Examiner respectfully disagrees with the Applicant because the Examiner has clearly pointed out why the disclosure of the invention is not understood to an ordinary skill in the art rather certain phrases in claim 17 and the Examiner also considered other factors such as the breadth of the claims and the nature of the invention is unclear, there is no drawings to described prior art, there is no direction

provided by the inventor, no working example. Moreover, claim 17 claimed the structure described in Figs. 1, 2 and 3. In the specification, Fig. 3 is described as a schematic representation of a damping device between the assembly (of the assembly of Fig. 1 and 2) and the mounting fixed to the frame and there is a gap between the necessary structural connections between Fig. 2 and Fig. 3 for an ordinary skill in the art to understand. Even though Figs. 3 and 4 directed to schematic representation of further exemplary embodiments of the damping device, there is no further exemplary embodiment of the damping device is described. Figs. 1 and 9 show no lateral clearance between tabs 17 and wall 8, 8'. Fig. 7 appears to show side walls 8 and 8' similar to Fig. 2 but there is a gap between the necessary structural connections such as tab 17 is broken into two pieces in radial direction. For the reasons explained above, the rejection is still deemed proper.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Information on How to Contact USPTO***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh N Nguyen whose telephone number is (571) 272-2031. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quyen Leung, can be reached on (571) 272-8188. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1000.

HNN

January 3, 2009

/Nguyen N Hanh/

Primary Examiner, Art Unit 2834